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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,160	07/03/2006	Hanamanthsa Shankarsa Bevinakatti	118989-05154644	9154
20583	7590	01/13/2009		
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			EXAMINER BROOKS, CLINTON ALAN	
			ART UNIT 4121	PAPER NUMBER
			MAIL DATE 01/13/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/561,160

Applicant(s)

BEVINAKATTI, HANAMANTHSA  
SHANKARSA

Examiner

CLINTON BROOKS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Claims 1-17 are pending.

#### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, drawn to compounds of formulas I, II, and III. If Group I is elected a further species election is required.

Group II, claim(s) 9-14, drawn to an agrochemical composition. If Group II is elected a further species election is required.

Group III, claim(s) 15, drawn to a method of treating vegetation. If Group III is elected a further species election is required.

Group IV, claim(s) 16, drawn to a method of killing or inhibiting vegetation. If Group IV is elected a further species election is required.

Group V, claim(s) 17, drawn to method of killing plant pests. If Group V is elected a further species election is required.

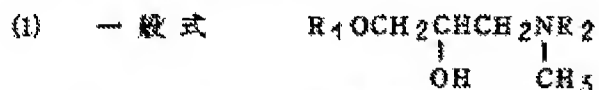
2. As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), "the international application shall relate to one invention only or to a group of inventions." Moreover, as stated in Rule 13.2 PCT, Unity of Invention is satisfied "where a group of inventions is claimed in one and the same international application, the requirement of

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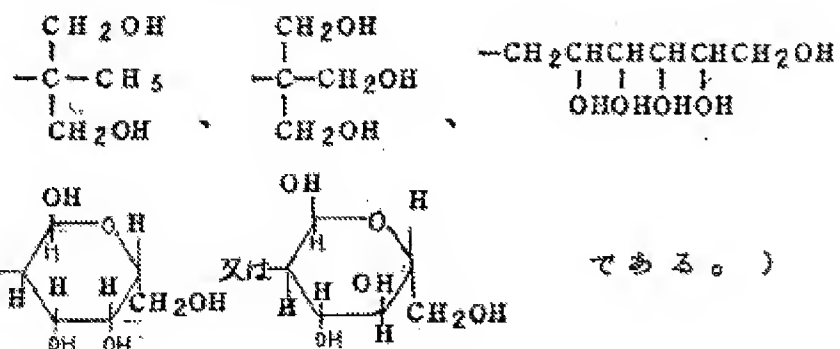
unity referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features."

3. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole makes over the prior art so linked as to form a single general inventive concept." The method of claim 1 in the instant application does not present a contribution over the prior art, as it is disclosed, and therefore anticipated. Specifically, Japanese patent no. JP-54163829 (the '829 patent) teaches a compound of formula (I), see structure below (column 2, lines 37 to 47). A relevant portion of the Derwent abstract follows the structure and is included in the references.

## 2. 特許請求の範囲



(式中で  $R_1$  は炭素数 10 ~ 22 のアルキル基又はアルケニル基、 $R_2$  は



4.

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ABSTRACTED-PUB-NO: JP 54163829 A  
BASIC-ABSTRACT:

Cosmetic compsn. contains 1 cpd. of formula  $R_1OCH_2-O(OH)HCH_2N(CH_3)R_2$  (I). In (I)  $R_1$  is 10-22C alkyl or alkenyl; and  $R_2$  is  $-C(CH_2OH)_2-CH_3$ ,  $-C(CH_2OH)_2-CH_2OH$ ,  $-CH_2-(CHOH)_4-CH_2OH$  or a gp. (VI) or (V). Pref.  $R_1$  includes n-decyl, n-dodecyl, n-tetradecyl, 2-pentylnonyl, n-hexadecyl, 2-hexyldecyl, n-octadecyl, 2-heptylundecyl, 2-(1,3,3-trimethyl)butyl-5,7,7-trimethyloctyl, n-9-octadecenyl, n-9, 12-octadecadienyl, n-9,12,15-octadecatrienyl, 2-octyldodecyl and n-docosyl. (I) is pref. combined as 0.1-30 w/w% in the cosmetics.

(I) have low toxicity, do not stimulate the skin and are readily dissolved or dispersed in water and oily cosmetic bases. Milky lotions, face lotions, hair conditioners, shampoos, rinses, etc. with high and good appearance and touch can be prepd. from (I).

5. As a result, as currently presented claim 1 does not possess a special technical feature in view of the prior art and, as such, Group I lacks a special technical feature.

6. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: A species of claim 1, formula (I), is known in the prior art.

7. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

If Applicant elects Group I, the following species elections are required:

- 1) the name and structure of a compound of formula I, II, and or III
- 2) the claims that read on the elected species,
- 3) the definition of the exact substitutions,  
e.g. Ar, R is methyl,  $R^1$  is ethyl, etc

If Group II is elected a further species election is required:

- 1) the name and structure of a specific adjuvant of formula (I),

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2) the claims that read on the elected species,

3) the definition of the exact substitutions,

e.g. Ar, R is methyl, R<sup>1</sup> is ethyl, etc

4) a specific plant growth regulator compound, (more specific than "at least one phosphonomethyl glycine", from claim 12)

If Group III is elected a further species election is required:

1) a specific compound composition,

2) the definition of the exact substitutions.

e.g. Ar, R is methyl, R<sup>1</sup> is ethyl, etc

If Group IV is elected a further species election is required:

1) the name and structure of one growth regulator,

2) a compound of general formula I (name and structure),

3) the definition of the exact substitutions,

e.g. Ar, R is methyl, R<sup>1</sup> is ethyl, etc

If Group V is elected a further species election is required:

1) the name and structure of one pesticide, fungicide or acaricide,

2) a compound of general formula I (name and structure),

3) the definition of the exact substitutions of the compound,

e.g. Ar, R is methyl, R<sup>1</sup> is ethyl, etc

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims

subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

8. The claims are deemed to correspond to the species listed above in the following manner:

Group I, claim(s) 1-8, drawn to compounds of formulas I, II, and III.

Group II, claim(s) 9-14, drawn to an agrochemical composition

Group III, claim(s) 15, drawn to a method of treating vegetation

Group IV, claim(s) 16, drawn to a method of killing or inhibiting vegetation.

Group V, claim(s) 17, drawn to method of killing plant pests

The following claim(s) are generic: Group 1, claim 1, 2; Group II, claim 9; Group III, claim 15; Group 4; Claim 15; Group V, claim 17.

9. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: A species of claim 1 is known in the prior art (see structure above)..

10. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

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requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

11. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during



prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLINTON BROOKS whose telephone number is (571)270-7682. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PATRICK NOLAN can be reached on (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Patrick J. Nolan/  
Supervisory Patent Examiner, Art Unit 4121